

MAY 02 2005

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office at (703) 872-9306, on
May 2, 2005
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By Juliana Hermes
Juliana Hermes

Attorney Docket No: 26-003700US
Client Ref: NS104D1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Peter Palese, et al.

Application No.: 09/396,539

Filed: September 14, 1999

For: **RECOMBINANT NEGATIVE
STRAND RNA VIRUS EXPRESSION
SYSTEMS AND VACCINES**

Examiner: Terry Alan McKelvey

Art Unit: 1636

Confirmation No.: 7591

PETITION PURSUANT TO 37 C.F.R.
1.47(a) TO ACCEPT SIGNED
DECLARATION ON BEHALF OF
NONSIGNING INVENTOR

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.47 (a), Applicants hereby petition the Patent Office to accept the attached signed Declaration on behalf of a nonsigning inventor.

The pertinent facts are as follows:

(a). Inventor Peter Palese signed an appropriate inventor declaration on 11/9/94, originally submitted in related application 08/252,508 and submitted in the current application on 11/10/99. To date, however, Inventor Peter Palese has declined to sign the new declaration submitted herewith listing the correct inventors.

(b). Inventor Peter Palese signed an Assignment Agreement with Mt. Sinai School of Medicine on May 17, 1990, which agreement stipulated that the inventor assigned his rights to the invention in "Recombinant Negative Strand RNA Virus Expression Systems and Vaccines" to Mt. Sinai. In turn, Mt. Sinai School of Medicine reassigned such rights to Aviron, Inc. on September 13, 1993. Aviron changed its corporate name to MedImmune Vaccines, Inc. on April 8, 2002. (See Exhibit A, which includes copies of such assignments and name change as well as the Statement under 37 C.F.R. §3.73(b))

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03 FC:1464 130.00 DA

Void date: 05/06/2005 EFLORES
05/06/2005 EFLORES 00000138 500893 09396539
03 FC:1464 130.00 CR

PAGE 12/49 * RCVD AT 5/2/2005 9:41:53 PM [Eastern Daylight Time] * SVR:USPTO-EFXXF-1/1 * DNIS:8729306 * CSID:5103377877 * DURATION (mm:ss):21:44

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Peter Palese, et al.
Application No.: 09/396,539
Page 2

(c.) The subject application was filed on September 14, 1999. The invention of the current application claims priority to, and was disclosed in the application as filed and assigned in subpart (b) above.

(d.) The declaration document to be signed by inventor Palese has been provided to him at least twice (at least once at his request) and he has been requested numerous times to sign the documents, both by undersigned counsel and by senior employees of the current owner of the application (Medimmune Vaccines, Inc.). He has declined to sign the declaration. Specifically:

i.) On 12/03/04 Documents (including copies of specification, original claims, allowed claims, and a letter explaining the need for a new Declaration in light of the need to correct inventorship, as well as the urgency for a quick response on the part of inventor Palese to correct inventorship in the current case) were mailed to Inventor Palese by Attorney Paul Littlepage of the Quine IP Law Group, PC, of Alameda, CA. These documents were received at Palese's home address on 12/06/04 (*see* Exhibit B).

ii.) On or about 12/10/04, Jonathan Klein-Evans (Senior Director, Intellectual Property at MedImmune, Inc., the parent company of MedImmune Vaccines, Inc.) received a telephone call from Dr. Peter Palese of the Mount Sinai School of Medicine ("Mt. Sinai") concerning documents that MedImmune's outside counsel Quine Intellectual Property Law Group had sent him to effectuate a change of inventorship. Dr. Palese told Mr. Klein-Evans that, because of a perceived conflict with Mt. Sinai, he would not sign a new Declaration for U.S. Patent Application Serial No. 09/396,539 (which Declaration would, due to claim amendments, add inventors Parvin and Krystal and delete inventor Garcia-Sastre).

iii.) On 1/31/05 in a telephone call between Todd Pazdera, Assistant Director of Mt. Sinai School of Medicine's Office of Industrial Liaison, and Mr. Klein-Evans, Mr. Klein-Evans informed Mr. Pazdera that Dr. Palese was an inventor on the subject application, but that he would not execute a declaration in order to correct the inventorship because of a perceived conflict with Mt. Sinai.

iv.) On 2/15/05 and 2/16/05, Mr. Klein-Evans left separate voice messages for Mr. Pazdera via telephone. On 2/16/05, Mr. Pazdera telephoned Mr. Klein-Evans in response and told him he had no answer for Klein-Evans at that time. Later on 2/16/05, Mr. Klein-Evans sent

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Page 3

an email to Mr. Pazdera concerning the change of inventorship in the subject application and requesting a response (*see* Exhibit C, hereto, which is a partially redacted copy of said email.)

v.) On 2/22/05, Mr. Klein-Evans left another voice message for Mr. Pazdera asking about the status of his request concerning Dr. Palese. On 2/25/05, Mr. Pazdera telephoned Mr. Klein-Evans and asked him for further information concerning the history of the subject patent application, which Mr. Klein-Evans communicated to Mr. Pazdera verbally.

vi.) On 3/4/05, Mr. Klein-Evans sent an email to Mr. Pazdera informing him of the serial numbers and filing dates of the priority applications of the subject application and providing him further explanation of the need to correct inventorship (*see* Exhibit C, hereto).

vii.) On 3/11/05, in an email, Mr. Pazdera indicated to Mr. Klein-Evans that the inventorship on the patent application was a matter for MedImmune and the inventors to determine and that, notwithstanding that Dr. Palese works at Mt. Sinai, Mt. Sinai would take no role in the process. Dr. Palese was copied on such email (*see* Exhibit D, hereto).

viii.) On 3/14/05 in a telephone conversation between Inventor Palese and Attorney Littlepage, Inventor Palese was again informed of the urgency for signing. Inventor Palese requested that new copies of documents be sent to him.

ix.) On 3/14/05 an additional set of documents were sent to Palese by Attorney Littlepage (including copies of specification, original claims, allowed claims, and letter explaining need for new Declaration and the extreme time urgency in having the documents signed so that inventorship could be corrected in the application). The documents were received at Palese's residence on 3/15/05 (*see* Exhibit E).

x.) On 3/21/05, in a telephone conversation between Inventor Palese and Attorney Littlepage, Inventor Palese indicated that he would not sign the Declaration at that time.

xi.) On or about 3/25/05, Dr. Palese telephoned Mr. Klein-Evans to tell him that he would not sign the Declaration at that time, and would only consider signing the Declaration if he were paid a royalty. Mr. Klein-Evans informed Dr. Palese that having already acquired title of the patent application from Mt. Sinai, that MedImmune would not pay royalties to him in order to correct inventorship.

xii.) On May 1, 2005, Mr. Klein-Evans spoke by telephone with Dr. Palese's attorney, Noah Scooler, provided him a summary of the situation, informed him that Dr. Palese and

Peter Palese, et al.
Application No.: 09/396,539
Page 4

members of MedImmune's management had discussed the issue without resolution over the prior few weeks, and that MedImmune would take steps to correct inventorship even without Dr. Palese's execution of the Declaration on May 2, 2005, in light of the pending issuance of the application. Mr. Scooler expressed Dr. Palese's desire for compensation in return for executing the Declaration. Mr. Scooler and Mr. Klein-Evans agreed to discuss the matter further on May 2, 2005.

xiii.) On May 2, 2005, a telephone conference took place between Dr. Palese's attorneys, Mr. Scooler and Cheryl Agris, and MedImmune employees Edward T. Mathers (Senior Vice President, Corporate Development), William C. Bertrand (Vice President, General Counsel), and Mr. Klein-Evans. Mr. Scooler again expressed that Dr. Palese was seeking compensation in exchange for executing the documents. Both Mr. Scooler and Ms. Agris expressed that they had not yet confirmed that the inventorship correction was necessary. Mr. Mathers expressed that MedImmune would not provide the compensation Dr. Palese was seeking. Mr. Bertrand informed Mr. Scooler and Ms. Agris that MedImmune would file a petition to correct inventorship without Dr. Palese's execution of the Declaration this same day if Dr. Palese did not agree to execute the Declaration. Mr. Scooler said he was due to talk to Dr. Palese later this same day. Later on May 2, 2005, Mr. Scooler telephoned Mr. Klein-Evans and told him that Dr. Palese would not execute the Declaration prior to MedImmune's filing a petition to correct inventorship.

xiv.) As of 5/02/05, Dr. Palese has refused to return a signed copy of the required Declaration.

Applicants note that the Application will issue as U.S. Patent No. 6,887,699 on 5/03/05. Inventorship must be corrected. Such action is necessary to preserve the rights of the Assignee.

The last know address for the Inventor is:
414 Highwood Avenue
Leonia, New Jersey 07605

Applicants respectfully request that the Patent Office accept the signature of Co-Inventors Jeffrey D. Parvin and Mark Krystal in lieu of Inventor Palese on the accompanying

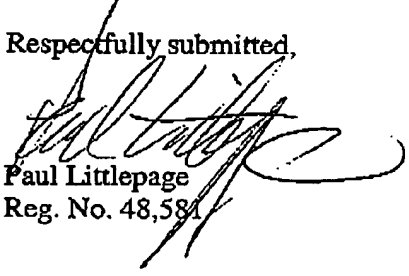
Peter Palese, et al.
Application No.: 09/396,539
Page 5

Declaration. Applicants note that M.P.E.P. §409.03(a) states that a Declaration "signed by all available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated."

Please charge \$130.00, pursuant to 37 C.F.R. 1.17(i), for entry and consideration of this petition to deposit account number 50-0893. In addition, please charge any other fee that is required for entry and consideration of this petition to the above noted deposit account, or credit any overpayment.

QUINE INTELLECTUAL
PROPERTY LAW GROUP, P.C.
P.O. BOX 458
Alameda, CA 94501
(510) 337-7871
Fax (510) 337-7877

Respectfully submitted,



Paul Littlepage
Reg. No. 48,581

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I hereby certify that this correspondence is being transmitted by facsimile
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on May 2, 2005

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By

Juliana Hermes
Juliana Hermes

Attorney Docket No. 26-003700US

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STRAND RNA VIRUS EXPRESSION
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Examiner: Terry Alan McKelvey

Art Unit: 1636

Confirmation Number: 7591

DECLARATION ACCOMPANYING
PETITION UNDER 37 C.F.R. 1.47 (a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Jonathan Klein-Evans, of 22221 Creekview Drive, Gaithersburg, MD, 20882, hereby
declare as follows:

1. I hold the position of Senior Director, Intellectual Property at MedImmune, Inc., the parent company of MedImmune Vaccines, Inc (collectively "MedImmune").
2. On or about 12/10/04, I received a telephone call from Dr. Peter Palese of the Mount Sinai School of Medicine ("Mt. Sinai") concerning documents that MedImmune's outside counsel Quine Intellectual Property Law Group had sent him to effectuate a change of inventorship. Dr. Palese told me that, because of a perceived conflict with Mt. Sinai, he would not sign a new Declaration for U.S. Patent Application Serial No. 09/396,539 (which Declaration would, due to claim amendments, add inventors Parvin and Krystal and delete inventor Garcia-Sastre).
3. On 1/31/05 in a telephone call between Todd Pazdera, Assistant Director of Mt. Sinai School of Medicine's Office of Industrial Liaison, and myself, I informed Mr. Pazdera that Dr. Palese was an inventor on the subject application, but that he would not execute a declaration in order to correct the inventorship because of a perceived conflict with Mt.

Peter Palese, et al.
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Sinai.

4. On 2/15/05 and 2/16/05, I left separate voice messages for Mr. Pazdera via telephone. On 2/16/05, Mr. Pazdera telephoned me in response and told me he had no answer for me at that time. Later on 2/16/05, I sent an email to Mr. Pazdera concerning the change of inventorship in the subject application and requesting a response (*see Exhibit C, hereto*, which is a partially redacted copy of said email.)
5. On 2/22/05, I left another voice message for Mr. Pazdera asking about the status of my request concerning Dr. Palese. On 2/25/05, Mr. Pazdera telephoned me and asked me for further information concerning the history of the subject patent application, which I communicated to Mr. Pazdera verbally.
6. On 3/4/05, I sent an email to Mr. Pazdera informing him of the serial numbers and filing dates of the priority applications of the subject application and providing him further explanation of the need to correct inventorship (*see Exhibit C, hereto*).
7. On 3/11/05, in an email, Mr. Pazdera indicated to me that the inventorship on the patent application was a matter for MedImmune and the inventors to determine and that, notwithstanding that Dr. Palese works at Mt. Sinai, Mt. Sinai would take no role in the process. Dr. Palese was copied on such email (*see Exhibit D, hereto*).
8. On or about 3/25/05, Dr. Palese telephoned me to tell me that he would not sign the Declaration at that time, and would only consider signing the Declaration if he were paid a royalty. I informed Dr. Palese that having already acquired title of the patent application from Mt. Sinai, that MedImmune would not pay royalties to him in order to correct inventorship.
9. On May 1, 2005, I spoke by telephone with Dr. Palese's attorney, Noah Scooler, provided him a summary of the situation, informed him that Dr. Palese and members of MedImmune's management had discussed the issue without resolution over the prior few weeks, and that MedImmune would take steps to correct inventorship even without Dr. Palese's execution of the Declaration on May 2, 2005, in light of the pending issuance of the application. Mr. Scooler expressed Dr. Palese's desire for compensation in return for executing the Declaration. Mr. Scooler and I agreed to discuss the matter further on May 2, 2005.

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10. On May 2, 2005, a telephone conference took place between Dr. Palese's attorneys, Mr. Scooler and Cheryl Agris, and MedImmune employees Edward T. Mathers (Senior Vice President, Corporate Development), William C. Bertrand (Vice President, General Counsel), and myself. Mr. Scooler again expressed that Dr. Palese was seeking compensation in exchange for executing the documents. Both Mr. Scooler and Ms. Agris expressed that they had not yet confirmed that the inventorship correction was necessary. Mr. Mathers expressed that MedImmune would not provide the compensation Dr. Palese was seeking. Mr. Bertrand informed Mr. Scooler and Ms. Agris that MedImmune would file a petition to correct inventorship without Dr. Palese's execution of the Declaration this same day if Dr. Palese did not agree to execute the Declaration. Mr. Scooler said he was due to talk to Dr. Palese later this same day. Later on May 2, 2005, Mr. Scooler telephoned me and told me that Dr. Palese would not execute the Declaration prior to MedImmune's filing a petition to correct inventorship.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Jonathan Klein-Evans

May 2, 2005
Date

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Juliana Hermes

Attorney Docket No. 26-003700US

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DECLARATION ACCOMPANYING
PETITION UNDER 37 C.F.R. 1.47 (a)Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

I, Paul Littlepage, of 86 Cañada Road, Woodside, CA, 94062, hereby declare as follows:

1. On 12/03/04 I mailed, via Federal Express, Documents to Inventor Palese (including copies of the specification of U.S. Patent Application Serial No. 09/396,539, original claims of such application, allowed claims of such application, and a letter explaining the need for a new Declaration in light of the need to correct inventorship, and the urgency for a quick response on the part of inventor Palese to correct inventorship). These documents were received at Palese's home address on 12/06/04 (see Exhibit B);
2. In a telephone conversation on or about 3/14/05 I again informed Inventor Palese of the urgency for signing a new Declaration. Inventor Palese requested that I send new copies of the above listed documents to him. I further declare that I sent such documents via Federal Express (including copies of the specification, original claims, and allowed claims, and letter explaining the need for new a Declaration and the extreme time urgency in having the documents signed so that inventorship could be corrected in the application) to Palese. The documents were received

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at Palese's residence on 3/15/05 (*see* Exhibit E);

3. In a telephone conversation on or about 3/21/05, between myself and Inventor Palese, Inventor Palese indicated that he would not sign the Declaration at that time.

4. As of May 2, 2005, Inventor Palese has not returned a signed copy of the required Declaration to me.

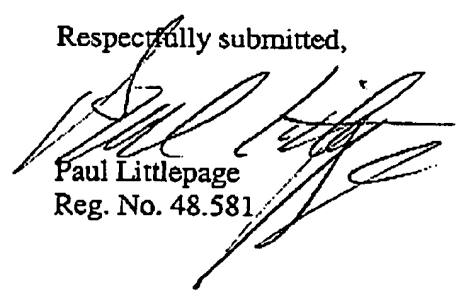
I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Paul Littlepage


Date

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Respectfully submitted,


Paul Littlepage
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